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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/594,255

08/18/2008

Keiichi Kitahara

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1870

23432 7590 10/05/2009  
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EXAMINER

ROBINSON, ELIZABETH A

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

10/05/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/594,255	<b>Applicant(s)</b> KITAHARA ET AL.	
	<b>Examiner</b> Elizabeth Robinson	<b>Art Unit</b> 1794	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 14 September 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☒ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: 1-3, 5 and 8-13.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
 13. ☐ Other: \_\_\_\_\_.

/Callie E. Shosho/  
 Supervisory Patent Examiner, Art Unit 1794

E. R./  
 Elizabeth Robinson  
 Examiner, Art Unit: 1794

Continuation of 3. NOTE: The amendment will not be entered since the amendment changes the range of the ultraviolet absorber content to a range not previously claimed and adds the newly claimed limitation that the weight percentage for the spherical microparticles is for the cured layer. This raises new issues that would require further consideration and/or search.

Regarding the 35 U.S.C. 112, first paragraph rejection, the claim amendments do not overcome this rejection. The rejection was not over the numerical values of the range of the filler, but rather that there is no support in the instant specification that the weight ratios or weight percentages are based on the weight after curing. The addition of the limitation that the weight percentage of the microparticles is based on the weight when the layer has been cured is also not supported and would raise new 35 U.S.C. 112, first paragraph rejections.

The proposed claim amendments, if entered, would overcome the 35 U.S.C. 112, second paragraph rejections of record.

Applicant argues that none of the references teach the claimed combination of an ionizing radiation curable resin, spherical microparticle of a particular size, shape and concentration and an ultraviolet absorber having a specific formula weight and concentration. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Regarding the 35 U.S.C. 103(a) rejection over Onozawa et al. (US 6,103,370) in view of Nakamura et al. (US 2002/0085284) and in view of the Ciba® TINUVIN® 328 and 1130 product literature, while Nakamura and the Ciba® TINUVIN® 328 and 1130 product literature do not disclose all the features of the present claimed invention, Nakamura and the Ciba® TINUVIN® 328 and 1130 product literature are used as teaching references, and therefore, it is not necessary for these secondary references to contain all the features of the presently claimed invention. *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973). *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather these references teach certain concepts, namely the preferred size and shape of the filler to be used in the amount as taught by Onozawa and the effectiveness and loading for an ultraviolet absorber, and in combination with the primary reference, disclose the presently claimed invention.

Regarding the 35 U.S.C. 103(a) rejection over McMan et al. (US 2004/0241469) in view of Onozawa et al. (US 6,103,370) and Nakamura et al. (US 2002/0085284), while Onozawa and Nakamura do not disclose all the features of the present claimed invention, Onozawa and Nakamura are used as teaching references, and therefore, it is not necessary for these secondary references to contain all the features of the presently claimed invention. *In re Nievelt*, 482 F.2d 965, 179 USPQ 224, 226 (CCPA 1973). *In re Keller* 624 F.2d 413, 208 USPQ 871, 881 (CCPA 1981). Rather these references teach certain concepts, namely the preferred size, shape, material and loading of the filler, and in combination with the primary reference, disclose the presently claimed invention.

Applicant argues that the examples of Onozawa only propose adding 1 to 1.5 parts by weight of absorber. However, "applicant must look to the whole reference for what it teaches. Applicant cannot merely rely on the examples and argue that the reference did not teach others." *In re Courtright*, 377 F.2d 647, 153 USPQ 735,739 (CCPA 1967). While the examples of Onozawa show some absorber loading examples, Onozawa does not preclude other absorber loadings. As set forth in the Final Office Action, it would be obvious to one of ordinary skill in the art to vary the amount of absorber of Onozawa to amounts, including those presently claimed, in order to obtain a desired degree of ultraviolet absorption as is taught by the TINUVIN® 328 product literature.

Applicant argues that none of the references teach or suggest that the spherical particles have the effect of suppressing the yellowing of the anti-ultraviolet layer. However, since the combination of the references discloses the same combination as in the instant application this structure would intrinsically have this property. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).